

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
GOLDENBERG
Serial No.: 09/313,278
Filed: May 18, 1999
Title: VIRTUAL DOCTOR INTERACTIVE
CYBERNET SYSTEM
Group Art Unit: 2164
Examiner: Al Hashemi, Sana A
Attorney Docket No.: DMGO:001US
Confirmation No.: 3688

VIA EFS-WEB

BRIEF ON APPEAL UNDER 37 CFR §41.37

COMMISSIONER FOR PATENTS
P.O. Box 1450
ALEXANDRIA, VA 22313-1450

Sir:

This appeal brief is being filed in accordance with the provisions of 37 C.F.R. § 41.37. The fee of \$270.00 under Rule 17(c) for filing of this brief is addressed in the web-generated transmittal. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to deposit account 18-2056. By way of separate paper, appellant requests a one-month extension of the period for response. If any additional extension of time is needed for timely acceptance of papers submitted herewith, Appellant hereby petitions for such extension under 37 C.F.R. §1.136(a) and authorizes payment of any such extensions fees to Deposit Account No. 18-2056.

I. REAL PARTY IN INTEREST

The real party in interest in this application is the inventor, David Goldenberg.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to appellant or the appellant's legal representative which are related to, will directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Pending claims: 39-51

Canceled claims: 1-38 and 52-64

Rejected claims: 39-51

Appealed claims: 39-51

IV. STATUS OF AMENDMENTS

An amendment was filed subsequent to the final rejection dated July 31, 2008. Responsive to that amendment, the examiner withdrew finality and entered the proposed claim amendments. A new final rejection was mailed on November 19, 2008. No response was filed following the latter final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to a method of providing one of the group consisting of medical, veterinary, and other health care information on subjects of interest to a user. The method comprises accepting an inquiry from the user (Figure 3, element 301, and corresponding description at page 9, line 1 to page 10, line 23, with element 301 being particularly described at page 9, lines 2-5 – “when the user accesses the system in step 301 the system reads an inquiry from the user and recognizes it as an inquiry”); and determining a level of service based on the user inquiry (Figure 3, element 307, and corresponding description at page 9, lines 1, to page 10, line 23, with element 307 being discussed at page 9, line 28 – “system could determine user access level from a context of the user inquiry”). If the level of service is a first level of service, the method comprises determining a user sophistication based on the user inquiry; searching a database at an initial level using the search request, in order to identify information requested in the user inquiry; conditioning the search results based on the user sophistication; and providing the conditioned search results at the initial level to the user (page 10, lines 1-4). Figure 4 illustrates activities which take place at the first level of service, which is primarily a literature access service, as described at page 10, line 25 to page 11, line 6. Determining user sophistication based on user inquiry also is shown in Figure 3, elements 308, 309, 310 and 311, and corresponding description at page 9, line 1 to page 10, line 23, with elements 308, 309, 310 and 311 being particularly described at page 10, lines 17-23).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. The rejection of claims 39-50 under Section 103(a) based on Douglas *et al.* (US 6,039,688) in view of Nicol *et al.* (US 5,287,448).

2. The rejection of claim 51 under Section 103(a) based on Douglas *et al.* (US 6,039,688) in view of Official Notice.

VII. ARGUMENT

A. The rejection of claims 39-50 under Section 103(a) based on Douglas *et al.* (US 6,039,688) in view of Nicol *et al.* (US 5,287,448).

1. The examiner's argument

The examiner states that:

Douglas *et al.* describe a first level of service... The searching of the database in this case is the searching of the record in the computer system containing user's number of accumulated points and identifying the accumulated points, as well as details of the rewards system... Douglas differs in that it does not determine a level of user sophistication, or tailor the resulting information based on that sophistication. However, col. 8, lines 35-46 of Nicol *et al.* describe a help menu feature added to a user interface, in which a user enters their relative level of sophistication, such as "novice", "moderate", or "experienced". The search results then presented to the user in response to an information request is then specifically tailored to the input sophistication. A more experienced user will receive less information and a less experienced user will receive more information. Accordingly, it would have been obvious to one of ordinary skill in the art to modify Douglas *et al.* to incorporate a help menu at any one or all of its user interfaces for input of user sophistication so as to tailor the specific output results to the user's level of sophistication.

2. User sophistication in the present invention is determined "*based on the user inquiry,*" and this feature would not have been suggested by the combination of Douglas *et al.* and Nicol *et al.*

Even assuming, *arguendo*, that it would have been obvious to incorporate a *help menu* at one or all of the user interfaces of Douglas *et al.* so as to tailor output results to the level of user sophistication, the result still would not be the invention which is recited in claim 39. Claim 39 recites that in the case of a first level of service (the examiner finding that Douglas describes a first

level of service), user sophistication is determined “*based on the user inquiry.*” This feature is described in the specification:

For example, a simple question such as “What is leukemia?” would generate a relatively simple level 1 response. In this case the processor would simply access a database of medical definitions and provide the appropriate response to the user. In contrast, a more sophisticated question such as one that describes symptoms in detail and uses extensive technical language would be interpreted by the processor as coming from a sophisticated user and could generate a more sophisticated response.

The examiner proposes to substitute a feature from Nicol, in which the user selects a sophistication level from a pull-down menu, into the behavior modification program of Douglas. Selection of sophistication level by the user from a pull-down menu is quite different from the situation in which the processor assesses a user inquiry and “determine[s] a user sophistication *based on the user inquiry.*” In one case, sophistication level is determined *by the processor* based on the user’s inquiry, while in the other case, sophistication level is determined *by the user*. This feature of determining sophistication level *based on user inquiry* is nowhere to be found in the combination of Douglas and Nicol. Even when the two references are combined as in the rejection, the result is not the same as that which is set forth in claim 39.

Moreover, it is noted that Douglas is a therapeutic behavior modification program, compliance monitoring, and feedback system having a series of milestones for an individual to achieve lifestyle changes. In making the present rejection, the examiner proposes to modify the accumulated points output in Douglas based on the user’s sophistication level. It is difficult to understand how this would operate. Would two users that have accumulated the same number of points be told that they actually have accumulated differing numbers based on their sophistication level? If so, this would be contrary to the purpose of the Douglas program, which is to provide milestones by which users can judge their progress in achieving certain goals, such as weight loss or exercise levels.

In its decision, the Board noted that Douglas arguably suggests the need for different levels of service for different categories of users, citing the disclosure that members in the wellness group may not need all the features available to members of the clinical group. However, here again there is no suggestion that level of service should be *based on user inquiry*. A user’s status as “wellness group” or “clinical group” in the Douglas system is inputted by the physician or case advisor, and is

not based on “user inquiry.” Hence, this disclosure in Douglas also fails to suggest the invention as presently claimed when combined with Nicol. No *prima facie* case of obviousness of claim 51 exists based on Douglas *et al.* (US 6,039,688) in view of Nicol *et al.* (US 5,287,448), and reconsideration and withdrawal of this ground of rejection is respectfully requested.

While no *prima facie* case of obviousness exists with respect to any of the claims on appeal, additional bases for patentability exist with respect to various dependent claims, as will be addressed in the following sections.

3. The combination of references fails to teach a second level of service as described in claim 40 or 41.

Claims 40 and 41 more particularly describe a second level of service in which the database is searched at a subsequent level using the search request, in order to identify more information requested in the user inquiry than in the initial level; and providing the search results at the subsequent level to the user. The examiner cites column 16, lines 21-55 as describing a second level of service in which searches are made on a database in order to locate more information. However, the library search at the cited portion of Douglas is not made on the basis of an initial user inquiry (“using the search request”), as in the present claims. The first level identified by the examiner is the user’s examination of his reward points, the library feature of column 16, lines 21 *ff*, is not related to the initial user inquiry identified by the examiner (the reward points feature). In appellant’s claims, the same user inquiry is referenced in the first two levels of service identified in appellant’s claims (note the use of the definite antecedent “the” when referring to the user inquiry). The second level of service specifies providing more information “requested in the user inquiry than in the initial level.”

Here also, selection of sophistication level by the user from a pull-down menu is quite different from the situation in which the processor assesses a user inquiry and “determine[s] a user sophistication *based on the user inquiry*.” For both of these reasons, the combination of Douglas and Nicols fails to suggest the claimed second level of service as recited in appellant’s claims.

4. The combination of references fails to teach a third level of service as described in claims 40, 42 and 46.

Claims 40, 42 and 46 more particularly describe a third level of service in which the user is provided with a list of health care professionals conditioned based on the user inquiry, and the user inquiry is referred to a health care professional selected by the user. The examiner identifies

Figure 48 of Douglas for this feature. Figure 48 shows video conferencing between patient and doctor. However, the doctor is not selected by the user from a list conditions based on the user inquiry. Doctor-patient contact in Douglas already exists before the patient ever uses the system, and not based on a user inquiry to the system. As described in Douglas:

In an exemplary scenario, a physician prescribes parameters and goals for such a therapeutic behavior modification program to help a patient recover from an ailment or surgical procedure, and these are input into the computer-implemented system. (column 2, lines 23-27)

The physician can then place the patient on the system to help him or her make these desirable or necessary lifestyle and behavior modifications. (column 6, lines 13-16)

In other words, the health care professional sets up the patient in the computer system, which then provides

electronically deliverable patient therapeutic behavior modification program, compliance, monitoring, and feedback system which supports the design of customized therapeutic behavior and lifestyle modification programs for subscribers. (column 2, lines 10-12)

There is no user inquiry until a patient is placed in the system by his doctor. Therefore, Douglas does not describe a level of service in which “the user is provided with a list of health care professionals conditioned based on the user inquiry, and the user inquiry is referred to a health care professional selected by the user.”

5. The combination of references fails to teach a third level of service as further described in claim 48.

Claim 48 recites that the third level of service further comprises accepting preferences, from the user, regarding health care professionals, creating a weighing function to rank order health care professionals, and accepting a selection, from the user, of the health care professional. The examiner cites Figure 57 for this feature:

Douglas *et al.* illustrates a utilization review system. The user preference is the norm established for the percentage of patients which are desired to be using the system (The listed norm is 17.3%). The weighing function is the measurement of each physician's percentage of patients who participate in the program. The physicians are thus ranked by the percentage of the patients under their supervision who participate in the program. The selection of the

user is the designation of which physicians are on the list shown in
FIG. 57

However, Figure 57 relates to one of several options available to health plan payors and not physicians/case advisors, and clearly not to patients. It allows health plan payors to assess physicians within a selected group or facility. It is not used for selection of a health care provider by a user, and it is not based on preferences from the user.

B. The rejection of claim 51 under Section 103(a) based on Douglas *et al.* (US 6,039,688) in view of Official Notice.

The Examiner takes Official Notice that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician-patient interaction, and that it would have been obvious to modify Douglas to include a recommendation to the remote patient that the patient undergo surgery so as to improve the patient's health. However, such recommendation is not "administering treatment" and it is not the transmission of signals over a network that relate to the actual performance of remote surgery, as presently claimed. No *prima facie* case of obviousness of claim 51 exists based on Douglas *et al.* (US 6,039,688) in view of Official Notice.

VIII. CONCLUSION

For these reasons, the Board is requested to reverse the decision of the examiner and pass the present case to issuance.

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP

MARCH 19, 2009

DATE

/BARBARA A. McDOWELL/

BARBARA A. McDOWELL

REG. NO. 31,640

P.O. Box 826

ASHBURN, VA 20146-0826

703-726-6020 (PHONE)

703-726-6024 (FAX)

CLAIMS APPENDIX

39. A method of providing one of the group consisting of medical, veterinary, and other health care information on subjects of interest to a user, the method comprising:

accepting an inquiry from the user;

determining a level of service based on the user inquiry; and if the level of service is a first level of service:

determining a user sophistication based on the user inquiry;

searching a database at an initial level using the search request, in order to identify information requested in the user inquiry;

conditioning the search results based on the user sophistication; and

providing the conditioned search results at the initial level to the user.

40. The method of claim 39, further comprising at least one of:

(A) if the level of service is a second level of service:

searching the database at a subsequent level using the search request, in order to identify more information requested in the user inquiry than in the initial level; and

providing the search results at the subsequent level to the user;

(B) if the level of service is a third level of service:

providing the user with a list of health care professionals conditioned based on the user inquiry; and

referring the user inquiry to a health care professional selected by the user;

(C) if the level of service is a fourth level of service:

monitoring a physiological condition of the user relating to the user inquiry; and administering treatment to the user.

41. The method of claim 40, wherein the method includes at least (A).

42. The method of claim 41, wherein the method includes at least (B).

43. The method of claim 42, wherein the method includes at least (C).

44. The method of claim 43, wherein the first level of service is performed before the second level of service, wherein the second level of service is performed before the third level of service, and wherein the third level of service is performed before the fourth level of service.

45. The method of claim 41, wherein the method includes at least (C).

46. The method of claim 40, wherein the method includes at least (B).

47. The method of claim 46, wherein the method includes at least (C).

48. The method of claim 46, wherein the third level of service further comprises:

accepting preferences, from the user, regarding health care professionals;

creating a weighing function to rank order health care professionals; and

accepting a selection, from the user, of the health care professional.

49. The method of claim 40, wherein the method includes at least (C).

50. The method of claim 49, wherein administering treatment to the user comprises transmitting instructions over a network to effect the release of a chemical or drug into the user through an implanted device.

51. The method of claim 49, wherein administering treatment to the user comprises transmitting instructions over a network to perform remote surgery.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of this title, and no other evidence was entered by the examiner and relied upon by appellant in the appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.